

REMARKS

Claims 27-33 are pending in the present application. By this amendment, Claim 27 is amended; and Claims 1-26 and 34-37 are canceled. Applicants respectfully request reconsideration of the present claims in view of the foregoing amendments and the following remarks.

I. Formal Matters:

Rejections Under 35 U.S.C. § 112, 1st paragraph

Claims 27-33 stand rejected under 35 U.S.C. § 112, first paragraph as allegedly containing subject matter that was not described in the specification in such a way as enable the present invention. This rejection is respectfully traversed.

More specifically, the application is allegedly not enabled for “a base polymer having carboxyl groups.” The application is also allegedly not enabled for “a carboxylic acid or derivative thereof.” The present invention is also allegedly not enabled for “a divalent or trivalent metal.” The application is also allegedly not enabled for “an amine or amino acid.” Lastly, the present invention is allegedly not enabled for “a neutralizing agent.”

Applicants respectfully submit that Claim 27 has been amended to clarify the claim and to ensure that Claim 27 is enabled to one of ordinary skill in the art.

More specifically, in regards to the language “a base polymer having carboxyl groups,” it is respectfully submitted that the Examiner is correct that many of the beneficial base polymers listed in the Specification do not have a carboxylate group. It is respectfully submitted that one of ordinary skill in the art would recognize that the inclusion of the language “having carboxylate groups” was in error and Applicants have deleted this language from the Specification at page 5 and in Claim 27. Applicants respectfully submit that page 5, line 24 supports this amendment and that no new matter has been added. As shown at page 5, line 24, the language is “suitable base polymers” and not “suitable base polymers having carboxylate groups” and the examples provided further support that the language at page 5, lines 12-13 and Claim 27 should read “suitable base polymers” as many of the examples cited do not have carboxylate groups. Accordingly, it is respectfully submitted that this informality has been corrected and respectfully submit that Applicants’ claimed invention is enabled for “a base polymer”.

In regards to the language “a carboxylic acid or derivative thereof,” it is respectfully submitted that the Examiner is misreading the Specification. The Examiner states that “the term ‘carboxylic acids’ embraces a class of compounds that may include amino acids and other species either not suitable nor compatible for inclusion.” However, it is respectfully submitted that, as shown at page 5, lines 20-24, the carboxylic acid or carboxylated polymer has groups that are “present to **react** with an amine group or amino group” (emphasis added). As such, any carboxylic acid that satisfies this function may be used and representative examples are provided. As such, it is respectfully submitted that the term “a carboxylic acid or derivative thereof” is not used in derogation of its meaning. In regards to the language “(d)erivatives of carboxylic acid include . . . copolymers, blends and mixtures”, the Examiner states that “a copolymer is not a derivative.” However, Applicants respectfully submit that Applicants have shown that for the present application, a derivative of carboxylic acid is defined to include a copolymer having a carboxylic acid as one of the polymers. As such, it is respectfully submitted that one of ordinary skill in the art would recognize that the a copolymer having a carboxylic acid polymer would be a derivative of carboxylic acid as used in the Specification and that the term is properly enabled.

In regards to the language “a divalent or trivalent metal,” it is respectfully submitted that Claim 27 has been amended to recite “a compound including a divalent or trivalent metal”. As this is supported at page 6, line 32, it is respectfully submitted that no new matter has been added. It is respectfully submitted that this amendment addresses the Examiner’s concerns regarding any alleged confusion as to what is contemplated by the term “a divalent or trivalent metal.”

In regards to the language “an amine or amino acid,” it is respectfully submitted that this term is properly enabled. Applicants respectfully submit that Applicants have provided a function for the amine or amino acid and have provided classes of compounds and specific examples of amines or amino acids that are capable of performing this function. Additionally, it is respectfully submitted that Applicants are under no duty to specifically point out each and every amine or amino acid that is capable of performing the recited functions. If the Examiner is going to impart such a duty, it is requested that the Examiner provide a basis for this request. According to M.P.E.P. § 2164.02, Applicants have provided a claimed genus and representative examples and respectfully submit that, based upon the function of the claimed genus and representative

examples, there would not be any undue experimentation to one of ordinary skill in the art to determine other examples in the genus that satisfy the recited function and, therefore, fall within the scope of the claimed invention. As the Examiner has not provided any “adequate reasons” for stating that one of ordinary skill in the art would be unable to determine other examples without undue experimentation, it is respectfully submitted that the term “an amine or amino acid” is properly enabled.

In regards to the language “a neutralizing agent,” it is respectfully submitted that this term is properly enabled. Applicants respectfully submit that Applicants have provided a function for the neutralizing agent and have provided specific examples of neutralizing agents that are capable of performing this function. As previously discussed, M.P.E.P. § 2164.02, provides that if Applicants have provided a claimed genus and representative examples, a term is enabled absent a showing by the Examiner of “adequate reasons” for stating that one of ordinary skill in the art would be unable to determine other examples without undue experimentation. As the Examiner has provided no such reasons, it is respectfully submitted that the term “a neutralizing agent” is properly enabled.

Accordingly, since the informalities discussed have been corrected or are not informalities, it is respectfully submitted that Claim 27 is enabled by the Specification. Accordingly, Applicants respectfully request withdrawal of this rejection.

Rejections Under 35 U.S.C. § 112, 2nd paragraph

Claims 27-33 stand rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for the proper metes and bounds of the terms mentioned above. This rejection is respectfully traversed. As previously discussed, Applicants respectfully submit that Claim 27 has been amended accordingly such that the proper metes and bounds of the terms mentioned above are enabled. As such, since the informalities discussed have been corrected or are not informalities, it is respectfully submitted that Claim 27 is enabled and, therefore, the terms therein are definite. Accordingly, Applicants respectfully request withdrawal of this rejection.

II. Prior Art:

The Examiner acknowledges that the prior art of record does not negate the patentability of Applicants’ claimed invention. Accordingly, as Applicants have

rectified any claim informalities, Applicants respectfully submit that the present application is in condition for allowance and respectfully request notification to this effect.

III. Conclusion:

For at least the reasons given above, Applicants submit that Claims 27-33 define patentable subject matter. Accordingly, Applicants respectfully request allowance of these claims.

The foregoing is submitted as a full and complete Response to the Office Action mailed April 16, 2003, and early and favorable consideration of the claims is requested.

Should the Examiner believe that anything further is necessary in order to place the application in better condition for allowance, the Examiner is respectfully requested to contact Applicants' representative at the telephone number listed below.

No additional fees are believed due; however, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 11-0855.

Respectfully submitted,



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